

Attorney Docket No.: DEX-0188
Inventors: Roberto A. Macina
Serial No.: 09/806,301
Filing Date: July 27, 2001
Page 6

REMARKS

Claim 1 and 11-24 are pending in the instant application. Claims 1 and 11-24 have been rejected. Claims 1, 14, 15, 18, 19, 22 and 23 have been amended. Claims 16, 20 and 24 have been canceled. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 1 and 11-24 under 35 U.S.C. 112, second paragraph

Claims 1 and 11-24 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner suggests that there is a lack of correlation in the claims. Specifically, the Examiner suggests that in the preamble, the purpose of the method is the detection of prostate cancer, ovarian cancer or uterine cancer while the steps of the method include measurement of ESBPII levels in any cell type, any tissue type and in any bodily fluid. Thus, the Examiner suggests that it is not clear how the claimed methods are distinguished from a method for diagnosis of breast cancer based upon levels of ESBPII polypeptide.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to

Attorney Docket No.: DEX-0188
Inventors: Roberto A. Macina
Serial No.: 09/806,301
Filing Date: July 27, 2001
Page 7

delete the phrase bodily fluids and to specify the cell or tissue type. Support for this amendment is provided in the data presented at pages 17 through 24 of the instant specification.

Withdrawal of this rejection under 35 U.S.C. 112, first paragraph, is therefore respectfully requested.

II. Rejection of Claims 1, 11-13, 16, 17, 20, 21 and 24 under 35 U.S.C. 102(e)

Claims 1, 11-13, 16, 17, 20, 21 and 24 have been rejected under 35 U.S.C. 102(e) as being anticipated over Lehrer. The Examiner suggests the Lehrer teaches methods of detection of metastasis of prostate, uterine, or ovarian cancer comprising the detection of Lipophilin B polypeptide (same as ESBPII polypeptide) in bodily fluids such as blood (paragraphs 0029 and 0032). The Examiner suggests that because the claims are drawn to methods wherein the measurements are made in bodily fluid the claimed methods also read on detection of metastasis of prostate, uterine or ovarian cancer.

Accordingly, while not conceding in any way to the accuracy of the Examiner's position, but rather in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to be drawn to measurement in cells or tissues. Further Applicants have canceled dependent claims 16, 20 and 24.

Attorney Docket No.: DEX-0188
Inventors: Roberto A. Macina
Serial No.: 09/806,301
Filing Date: July 27, 2001
Page 8

Withdrawal of this rejection under 35 U.S.C. 102(e) is therefore respectfully requested.

III. Rejection of Claims 1, 11-13, 16, 17, 20, 21 and 24 under 35 U.S.C. 102(e)

Claims 1, 11-13, 16, 17, 20, 21 and 24 have been rejected under 35 U.S.C. 102(a) as being anticipated by Billing-Medel (U.S. Patent 6,183,952; issued February 6, 2001, filed August 15, 1997). The Examiner suggests that Billing-Medel teaches methods for diagnosing the presence of breast cancer comprising measuring a protein having the sequence of SEQ ID NO:2. The Examiner suggests that the claims appear to read on methods that are the same as those of detecting breast cancer because the claims are drawn to methods wherein the measurements are made in bodily fluid, or in any cell type or tissue type, and it is not clear how one distinguishes the measurement of breast cancer from any other cancer.

As discussed in Sections I and II, however, the claims have been amended to specify the cells or tissues and to remove reference to bodily fluids.

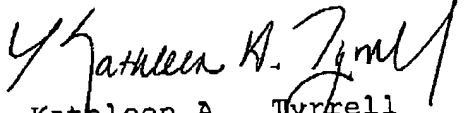
Withdrawal of this rejection under 35 U.S.C. 102(e) is therefore respectfully requested.

Attorney Docket No.: DEX-0188
Inventors: Roberto A. Macina
Serial No.: 09/806,301
Filing Date: July 27, 2001
Page 9

IV. Conclusion

Applicant believes that the foregoing comprises a full and complete response to the Advisory Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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